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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/020,139	12/18/2001	Roxanne Duan	PF348C1	7037

22195 7590 12/23/2003

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EXAMINER	
BELYAVSKYI, MICHAIL A	

ART UNIT	PAPER NUMBER
1644	

DATE MAILED: 12/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/020,139	DUAN ET AL.	
	Examin r	Art Unit	
	Michail A Belyavskyi	1644	

-- The MAILING DATE of this communication appears on th cover sheet with the correspondenc address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 August 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14,18-34 and 36* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14,18-34 and 36* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08/29/03 has been entered.

Claims 1-14, 18-34 and 36 are under consideration in the instant application.

2. In view of the amendment, filed 08/29/03 only the following rejections remain:

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-14, 18-34 and 36 stand rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention for the same reasons set forth in the previous Office Action, Paper No:13, mailed 03/24/03

Applicant's arguments, filed 08/29/03 have been fully considered, but have not been found convincing.

Applicant asserts that : (i) it is not necessary for the claimed polynucleotide or any polypeptide encoded thereby, to be biological active or to be defined by functional properties in order to be fully enabled; (ii) the specification does indeed teach and suggest the use of the claimed polynucleotide in the diagnosis of diseases, as disclosed in the specification on page 5, lines 28-32, page 8, lines 27-30, page 9, lines 22-28 and page 32 line 20 through 37, line 12; (iii) the claimed invention meets the statutory requirement for utility as set forth in 35 U.S.C. 101; (iv) the skilled molecular biologist, enlightened by the teaching of the present specification, is more than capable of routinely determining whether a polynucleotide has uses.

Contrary to Applicants assertion, the issue raised in the previous Office Action was if one skilled in the art clearly would know how to make and use the claimed invention. The Examiner respectively points out that this is the rejected under 35 U.S.C. 112, first paragraph, not utility rejection under 35 U.S.C.101. In the previous Office Action, Paper No:13, mailed 03/24/03, it was stated that " post filing date reference of Ashkenazi et al, (WO 00/53755 exhibit A) teaching that hPSP polypeptide was unregulated in primary colon tumors and in primary lung tumor has obviated the previous 35 U.S.C. 101 rejection of record". However , this do not obviate the issues of enablement rejection set forth in the previous Office Action , since the Specification as filed does not teach or suggest the use of the claimed polynucleotide in detecting the hPSP polypeptide in primary colon tumors and in primary lung tumor. The passages pointed by the Applicant only generally disclosed that : there is a need for identification and characterization of human polypeptides and genes encoding them, which can play a role in detecting, preventing, ameliorating or correcting disorders (page 5, lines 28-32); the invention provides methods for isolating antibody that binds to an hPSP polypeptide and are useful diagnostically or therapeutically (page 8, lines 27-30); assaying hPSP gene expression level , whereby an increase or decrease in the assayed hPSP gene expression level is indicative of disorder (page 9, line 23-28 and page 33, lines 15-20). It is not clear to the Examiner how these general statements teach and suggest the use of the claimed polynucleotide the diagnosis specific diseases. The specification does not disclose any diseases or conditions known to be associated with the hSLAP polypeptide , encoded by SEQ ID NO:2 or any conditions associated with altered levels (increase or decrese) of said polypeptide. Any protein may potentially be used as a treatment agent, and either increase or decrease during the course of disease. Since the fact pattern fails to establish what specific disease, would be diagnosable or treatable, the general statements of possible diagnosis or treatment does not obviate the issue of enablement rejection.

Also the issue is that the specification fails to provide guidance as how to make and use (1) *Any* isolated nucleic acid molecule, comprising a polynucleotide having a nucleotide sequence at least 95% identical to a sequence selected from the group recited in claim 1, or complete nucleotide sequence of SEQ ID NO:1 (claim 2), or nucleotide sequence in SEQ ID NO:1 encoding the hPSP polypeptide having the amino acid sequence in position –17 to +231 of SEQ ID NO:2 (claim 3), or nucleotide sequence in SEQ ID NO:1 encoding the mature form of the hPSP polypeptide having the amino acid sequence from about amino acid residue 1 to about amino acid residue 231 of SEQ ID NO:2 (claim 4); or complete nucleotide sequence of the cDNA clone contained in ATCC Deposit No 97811(claim 6), or nucleotide sequence encoding the hPSP polypeptide having the complete amino acid sequence except the N-terminal amino acid encoded by the cDNA clone contained in ATCC Deposit No 97811 (claim 7) or nucleotide sequence encoding the mature form of the hPSP (claim 8); (2) *any* isolated nucleic acid molecule comprising a polynucleotide having a nucleotide sequence at least 95 % identical to a sequence selected from the group recited in claim 5; (3) an isolated nucleic acid molecule comprising a nucleic acid sequence which encodes an epitope-bearing portion of an hPSP polypeptide selected from the group recited in claim 9; (4) a method of making *any* recombinant vector , (claims 10

and 31), *any* recombinant vector (claims 11 and 31), a method of making *any* recombinant host cell (claim 12) and a recombinant host cell (claims 13 and 33) and a method for producing a hPSP (claims 14 and 34); (5) *any* isolated nucleic acid molecule comprising a polynucleotide having a sequence at least 95 % identical to a sequence selected from the group recited in claim 18; (6) *any* isolated polynucleotide comprising a nucleic acid sequence selected from the group recited in Claim 19, or comprising SEQ ID NO:1 (claim 22) or encoding a mature polypeptide (claim 24) or identical to the human cDNA contained in ATCC Deposit No. 97811 (claim 25) or encoding at least 50 contiguous amino acids of SEQ ID NO:2 (claim 27) or complementary to the polynucleotide of claim 19 (claim 28) ; (8) *any* isolated polynucleotide of claim 19, further comprising a hetorologus polynucleotide (claim 29), wherein said heterologous polynucleotide encodes a heterologous polypeptide (claim 30); (9) a composition comprising *any* isolated polynucleotide of claim 19 (claim 36) without undue experimentation.

There does not appear to be sufficient guidance in the specification as filed as to how the skilled artisan would make and use the various nucleic acids recited in the instant claims. A person of skill in the art would not know which sequences are essential and which sequences are non-essential. There is insufficient guidance to direct a person of skill in the art to select particular sequences or sequence lengths as essential for the function of nucleic acid sequence of SEQ ID NO:1 and polypeptide encoded by the amino acid sequence of SEQ ID NO: 2. Moreover, there is insufficient guidance as to which "isolated polynucleotide comprising a heterologous polynucleotide", recited in the claim 29 and which "heterologous polypeptide" recited in claim 30, would maintain the same function as polypeptide encoded by amino acid sequence of SEQ ID NO: 2.

Also the issue is that the instant Claims encompass fragments. For example, claim 18 recite a nucleic acid comprising of a fragment of at least 30 contiguous nucleotides from 48 to 793 nucleotides of nucleotide sequence of SEQ ID NO: 1 or a complement thereof ,claim 19 recite a nucleic acid sequence encoding a polypeptide of at least 30 contiguous amino acid of SEQ ID NO:2 and claim 27 recite a nucleic acid sequence encoding a polypeptide of at least 50 contiguous amino acids of SEQ ID NO:2. There is insufficient guidance as to which nucleic acid residue within the nucleic acid sequence mention above or amino acid sequence within a polypeptide encoded by amino acid sequence of SEQ ID NO: 2 are *essential for the functional properties of nucleic acid molecule or the encoded polypeptide.*

Skolnick et al. (Trends in Biotech., 18(1):34-39, 2000) teach that the skilled artisan is well aware that assigning functional activities for any particular protein or protein family based upon sequence homology is inaccurate, in part because of the multifunctional nature of proteins (e.g., "Abstract" and "Sequence-based approaches to function prediction", page 34). Even in situations where there is some confidence of a similar overall structure between two proteins, only experimental research can confirm the artisan's best guess as to the function of the structurally related protein (see in particular "Abstract" and Box 2).

Ngo *et al* teach that the amino acid positions within the polypeptide/protein that can tolerate change such as conservative substitution or no substitution, addition or deletion which are critical to maintain the protein's structure will require guidance (see Ngo *et al.*, 1994, The protein Folding Problem and Tertiary Structure Prediction, pp.492-495). Similarly, Skolnick *et al.* (Trends in Biotech., 18(1):34-39, 2000) teach that sequence-based methods for function prediction are inadequate because of the multifunctional nature of proteins (see the abstract Page 34). Such a recitation does not require that the nucleic acid encode the full length sequence set forth in SEQ ID NO:1; but rather encompasses any nucleic acid sequence comprising either the full length of SEQ ID NO:1 or any contiguous nucleic acid residues. Without sufficient guidance, the changes which can be made in nucleic acid sequence of SEQ ID NO: 1 and still maintain activity is unpredictable and the experimentation left to those skilled in the art is unnecessarily, and improperly, extensive and undue.

In re Fisher, 1666 USPQ 19 24 (CCPA 1970) indicates that the more unpredictable an area is, the more specific enablement is necessary in order to satisfy the statute.

Reasonable correlation must exist between the scope of the claim and the scope of enablement set forth. Without sufficient guidance, the changes which can be made in the instantly recited nucleic acid sequences or proteins encoded by the recited nucleic acid sequences and still maintained the functional properties of SEQ ID NO: 1 and protein encoded by SEQ ID NO: 2 is unpredictable, as is the identity of which fragments would encode a functional polypeptide since the amino acids encoding a particular functional activity do not appear to have been identified; thus the experimentation left to those skilled in the art is unnecessary, improperly, extensive and undue.

In view of the quantity of experimentation necessary, absence of working examples, the unpredictability of the art, the lack of sufficient guidance in the specification, and the breadth of the claims, it would take undue trials and errors to practice the claimed invention.

5. Claims 1,5,9-14,18-20,26-34 and 36 stand rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention essentially for the same for the same reasons set forth in the previous Office Action, Paper No:13, mailed 03/24/03

Applicant's arguments, filed 08/29/03 have been fully considered, but have not been found convincing

Applicant asserts that : (i) The specification contains an adequate written description of the claimed polynucleotides since the instant specification defined the claimed genus through the recitation of the nucleic acid sequence of SEQ ID NO:1; (ii) Examiner has underestimate the level of skill in the art, since one skilled in the art can identify many species that the claims encompass.

Contrary to Applicants' assertions, the specification fails to provide sufficient guidance as to which core structure of SEQ ID NO: 1 is essential to maintain its functional activity and which changes can be made in the structure of SEQ ID NO: 1 and still maintained the same function. In addition: A) there is no indication of an isolated nucleic acid molecule comprising a polynucleotide having a nucleotide sequence at least with 95% identity to a sequences recited in claim 1 and disclosed on page 7, lines 1-23 page 18, line 1 to page 20, line 16 and at page 28 line 35 to page 29 line 2 that possesses that same functional properties as nucleic acid molecule of SEQ ID NO:1.

The Examiner notes that the claimed invention which is drawn to a genus of polynucleotide sequences may be adequately described if there is a (1) sufficient description of a representative number of species, or (2) by disclosure of relevant, identifying characteristics sufficient to describe the claimed invention in such full, clear, concise and exact terms that a skilled artisan would recognize applicant was in possession of the claimed invention. To satisfy the disclosure of a "representative number of species" will depend on whether one of skill in the art would recognize that the applicant was in possession of the necessary common attributes or features of the elements possessed by the members of the genus in view of the species disclosed. "Relevant, identifying characteristics" include structure or other physical and /or chemical properties, functional characteristics coupled with a known or disclosed correlation between function and structure, or a combination of such identifying characteristics sufficient to show the applicant was in possession of the claimed genus. (see Revised Guidelines for the Examination of Patent Applications Under the 35 U.S.C.112, ¶ 1 "Written Description" Requirement, Federal Register, Vol. 66, No.4, pages 1099-1111, Friday January 5, 2001).

In the instant case, however, there is insufficient description or art-recognized correlation or relationship between the structure of the invention, the nuclei acid sequence of SEQ ID NO:1 that encodes polypeptide hPSP of SEQ ID NO:2 and it's function that is essential to the instant invention. Therefore, one of skill in the art would not envisage, based on the instant disclosure, the claimed genus of variants, wherein the variants are: (1) *Any* isolated nucleic acid molecule, comprising a polynucleotide having a nucleotide sequence at least 95% identical to a sequence selected from the group recited in claim 1, (2) *any* isolated nucleic acid molecule comprising a polynucleotide having a nucleotide sequence at least 95 % identical to a sequence selected from the group recited in claim 5; (3) an isolated nucleic acid molecule comprising a nucleic acid sequence which encodes an epitope-bearing portion of an hPSP polypeptide selected from the group recited in claim 9; (4) a method of making *any* recombinant vector , (claims 10 and 31), *any* recombinant vector (claims 11 and 31), a method of making *any* recombinant host cell (claim 12) and a recombinant host cell (claims 13 and 33) and a method for producing a hPSP (claims 14 and 34); (5) *any* isolated nucleic acid molecule comprising a polynucleotide having a

sequence at least 95 % identical to a sequence selected from the group recited in claim 18; (6) *any* isolated polynucleotide comprising a nucleic acid sequence selected from the group recited in Claim 19, or encoding at least 50 contiguous amino acids of SEQ ID NO:2 (claim 27) or complementary to the polynucleotide of claim 19 (claim 28) ; (7) *any* isolated polynucleotide of claim 19, further comprising a heterologous polynucleotide (claim 29), wherein said heterologous polynucleotide encodes a heterologous polypeptide (claim 30); (8) a composition comprising *any* isolated polynucleotide of claim 19 (claim 36).

Applicant is directed to the Revised Guidelines for the Examination of Patent Applications Under the 35 U.S.C.112, ¶ 1 "Written Description" Requirement, Federal Register, Vol. 66, No.4, pages 1099-1111, Friday January 5, 2001).

6. No claim is allowed.

7. The prior art does not teach or suggest an isolated nucleic acid molecule of SEQ ID NO:1 and a cDNA clone contained in ATCC Deposit No. 97811.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michail Belyavskyi whose telephone number is (703) 308-4232. The examiner can normally be reached Monday through Friday from 9:00 AM to 5:30 PM. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 305-3014.

Michail Belyavskyi, Ph.D.
Patent Examiner
Technology Center 1600
December 15, 2003

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